

### Remarks

In addition to the amendments and remarks submitted in the Amendment and Response filed March 11, 2009, Applicants request that the Examiner consider the following supplemental remarks when reconsidering the rejections of claims 1-18, 20-75, and 78-88 under 35 U.S.C. §103(a) as being unpatentable over Sirhan *et al.* (U.S. 2002/0082679 A1), under 35 U.S.C. §103(a) as being unpatentable over Hossainy *et al.* (U.S. 6,153,252), and under 35 U.S.C. §103(a) as being unpatentable over Whitbourne *et al.* (U.S. 6,110,483).

In their response filed March 11, 2009, Applicants set forth that while the cited documents describe classes of polymers that encompass the polymers from which polymers used to form the miscible polymer blends in Applicants' claims may be selected, the cited documents neither teach nor suggest the selection of the recited combinations of polymers. The cited documents provide no blaze marks that would direct one skilled in the art to select polymers based on their miscibility and/or the recited differences in solubility parameter.

Applicants' position is supported for all of the reasons set forth in the response filed March 11, 2009. Applicants' position is further supported by a recent decision of the Federal Circuit. The Federal Circuit revisited the issue of the alleged obviousness of claimed subject matter in view of a generic disclosure that encompasses at least a portion of the claimed subject matter in *Süd-Chemie, Inc. v. Multisorb Technologies, Inc.*, 89 USPQ2d 1768 (2009). *Süd-Chemie, Inc.* involved a patent directed to a desiccant container made from a water-vapor-permeable, multilayered packaging material that included "compatible" polymeric materials, as the term "compatible" is defined in the specification of Süd-Chemie's patent. *Id.* at 1770. The patent was asserted against an alleged infringer, Multisorb, who argued that Süd-Chemie's patent was invalid as obvious over an earlier patent to Komatsu. The district court found that the polymeric materials in the Komatsu patent encompassed some of the "compatible" polymeric materials of Süd-Chemie's claims and granted summary judgment that Süd-Chemie's patent was invalid as obvious in view of the Komatsu patent. *Id.*

The Federal Circuit panel **REVERSED** the district court and critiqued the district court's analysis as follows:

Finally, claim 1 of the '942 patent requires that the inner surfaces of the microporous and laminate films be "comprised of compatible polymeric materials." The district court concluded that Komatsu teaches the use of compatible films because "[t]he Komatsu patent suggests the employment of the same materials claimed by the '942 patent to be 'compatible polymeric materials.'" It is true that Komatsu discloses the same general classes of materials that are identified in the '942 patent. Thus, both patents state that the microporous and laminate films can be made from polyethylene, polypropylene, and other polyolefinic materials. *See* Komatsu, col. 2, ll. 19-21; col. 3, ll. 12-15; '942 patent, col. 5, ll. 12-15, 47-50. However, in concluding that Komatsu teaches the use of compatible polymeric materials, the district court failed to acknowledge that the specified classes of materials comprise a large number of substances with quite different properties, and that various combinations of those materials can be compatible or incompatible depending on how they are assembled in layers to form the container.

*Id.* at 1772 (emphases added).

The Federal Circuit held that the district court erred in ruling that Süd-Chemie's patent was invalid as obvious over the Komatsu patent, disagreeing with the district court "with regard to its conclusion that Komatsu teaches the same materials on the container's inner surface as those claimed in [Süd-Chemie's] patent." *Id.*, at 1775.

The Federal Circuit's analysis in *Süd-Chemie* is directly applicable to the instant Application. The cited documents describe classes of polymers that may be blended, but those classes include innumerable species that have different properties, chief among those different properties are different solubility parameters. Thus, various combinations of members of the classes of polymers may possess the recited difference in solubility parameter or they may not, depending upon which members of the classes are selected.

Again, without guidance that directs one of ordinary skill in the art to miscible polymer blends having the recited difference in solubility parameter, the recitation of general classes of polymers and the general teaching that members of the classes may be combined does not render Applicant's miscible polymer blends obvious.

Supplemental Response

Serial No.: 10/640,853

Confirmation No.: 9178

Filed: August 13, 2003

For: ACTIVE AGENT DELIVERY SYSTEMS, MEDICAL DEVICES, AND METHODS

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Applicants respectfully submit the above remarks provide further support that claims 1-18, 20-75, and 78-88 comply with the requirements of 35 U.S.C. §103(a) and request that the rejections of claims 1-18, 20-75, and 78-88 as being unpatentable over Sirhan *et al.*, as being unpatentable over Hossainy *et al.*, and as being unpatentable over Whitbourne *et al.* be withdrawn.

Summary

It is respectfully submitted that the pending claims 1-18, 20-75, and 78-88 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the paper(s), as described hereinabove, are being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 CFR §1.6(a)(4) to the Patent and Trademark Office addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21<sup>st</sup> day of May, 2009.

By: 

Name: Deb Schurman

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